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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,494	04/03/2006	Yusuke Kida	1830.1040	9195

21171 7590 10/27/2009

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EXAMINER	
ASHBY, TANIA L	
ART UNIT	**PAPER NUMBER**
1611	

MAIL DATE	DELIVERY MODE
10/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/574,494	KIDA ET AL.	
	Examiner	Art Unit	
	TANIA ASHBY	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *11,12,20,21 and 26-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,13-19 and 22-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/25/08, 4/3/06, 7/31/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on July 21, 2009 is acknowledged.

Claims 11, 12, 21 and 26-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 21, 2009.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on April 3, 2006, January 25, 2008 and July 31, 2008 were noted and the submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statements.

Claim Objections

Claims 13, 16, 18, 19 and 22 are objected to as depending from a withdrawn base claim.

Appropriate correction is required.

For purposes of examination, claims 13, 16, 18, 19 and 22 have been interpreted to encompass the properties of base claims 11 and 21.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Oshimura et al. (EP 0826766, published March 4, 1998).

The Oshimura et al. reference (Oshimura) discloses a wash composition comprising a N-long-chain-acyl dipeptide or salt and a N-long-chain-acyl acidic amino acid exhibiting properties such as low irritation to skin, high resistance to water and an excellent feeling upon use (abstract). More specifically, Oshimura discloses that the dipeptide used can be N-(N'-long-chain-acyl-alpha-aspartyl) aspartic acid (page 3, lines 49-54) and that the N-long-chain-acyl acidic amino acid can be derived from aspartic acid and can have an acyl group having from 8-22 carbons (page 3, lines 54-56). Oshimura further discloses that the wash composition may contain other surface active

agents including higher fatty acids or salts thereof as component (C) of the invention (page 4, lines 38-42). The invention is further exemplified through Formulation Example 2 (page 13) where a shampoo is formed using 2% triethanolamine N-(N'-cocoyl-alpha-aspartyl) aspartate, 20% triethanolamine N-cocoyl aspartate and 4% coconut oil fatty acid diethanolamide. Given that Oshimura discloses the limitations of claim 1, claim 1 is anticipated by the reference.Regarding claim 22, given that Oshimura discloses a composition that is essentially identical to the cleansing composition that applicant is claiming [i.e. comprises component (A) of formula (1)], such a composition would inherently possess the claimed properties. Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada* 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10, 13-19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshimura et al. (EP 0826766, published March 4, 1998).

The rejection of claims 1and 22 has been addressed supra.

Oshimura teaches a wash composition comprising a N-long-chain-acyl dipeptide or salt and a N-long-chain-acyl acidic amino acid exhibiting properties such as low irritation to skin, high resistance to water and an excellent feeling upon use (abstract). More specifically, Oshimura teaches that the dipeptide used can be N-(N'-long-chain-acyl-alpha-aspartyl) aspartic acid (page 3, lines 49-54) and that the N-long-chain-acyl acidic amino acid can be derived from aspartic acid and can have an acyl group having from 8-22 carbons (page 3, lines 54-56). Oshimura further teaches that the wash composition may contain other surface active agents including higher fatty acids or salts thereof as component (C) of the invention (page 4, lines 38-42).

Oshimura, while teaching the incorporation of a long-chain-acyl dipeptide or a salt thereof, does not appear to explicitly teach (i.e. in a single example) the combination of N-acyl-diaspartic acids in a single preparation. Oshimura also does not appear to explicitly show the instantly claimed weight ranges or speak to the pH of the formulation.

It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of the Oshimura reference and include a combination of N-acyl-diaspartic acids (or salts). One would have been motivated to do so because the Oshimura reference suggests that the N-long-chain-acyl dipeptides can be used in combination with one another (page 3, line 39). Oshimura further exemplifies this suggestion by using dipeptide compositions of glutamate (page 13, Table 13).

It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Oshimura and arrive at the instantly claimed weight ranges. One would have been motivated to do so during the routine optimization process because Oshimura teaches that the ratio of the dipeptide component and the N-long-chain-acyl acidic amino acid may be varied between 0.1:100 and 20:100 while still achieving satisfactory results. Oshimura further teaches that the amount of component (C), the fatty acid or a fatty acid salt, can be up to 30%. This teaching is further exemplified through the formulations taught by pages 12-14 of the reference.

Regarding claim 2, page 3, line 39 of Oshimura teaches that that the N-long-chain-acyl dipeptides can be used in combination with one another (page 3, line 39).

Regarding claims 3-5, Oshimura teaches that the ratio of the dipeptide component and the N-long-chain-acyl acidic amino acid may be varied between 0.1:100 and 20:100 while still achieving satisfactory results. Oshimura further teaches that the amount of component (C), the fatty acid or a fatty acid salt, can be up to 30%. This teaching is further exemplified through the formulations taught by pages 12-14 of the reference.

Regarding claim 6, page 2 of the reference teaches that N-long-chain-acyl acidic amino acid salts exhibit excellent solution stability in the weakly acidic pH range. One having ordinary skill in the art would interpret a pH of 5.0-7.0 as “weakly acidic.” Although Oshimura does not appear to explicitly teach a formulation in the instantly claimed pH range, it would have been prima facie obvious to one having ordinary skill in

the art to adjust the pH to the weakly acidic range. One would have been motivated to do so because Oshimura teaches that such a range is mild to skin, exhibits less stretching feeling of the skin after use and also less irritation (page 2, lines 23-28).

Regarding claim 7, Oshimura teaches that the N-long-chain-acyl acidic amino acid is derived from aspartic acid and has an acyl group having 8 to 22 carbon atoms. Note that where the prior art ranges overlap or encompass the claimed ranges, a prima facie case of obviousness exists (MPEP 2144.05).

Regarding claims 8-10, Oshimura teaches that salts of alkali metals such as sodium, potassium, triethanolamine, ammonium, etc. can be used for both components (A) and (B). See page 3, lines 35-40 and page 4, lines 3-7. Additionally see Tables 13-15.

Regarding claim 13, page 3, line 39 of Oshimura teaches that that the N-long-chain-acyl dipeptides can be used in combination with one another.

Regarding claims 14-17, Oshimura teaches that the ratio of the dipeptide component and the N-long-chain-acyl acidic amino acid may be varied between 0.1:100 and 20:100 while still achieving satisfactory results. Oshimura further teaches that the amount of component (C), the fatty acid or a fatty acid salt, can be up to 30%. This teaching is further exemplified through the formulations taught by pages 12-14 of the reference.

Regarding claim 18, page 2 of the reference teaches that N-long-chain-acyl acidic amino acid salts exhibit excellent solution stability in the weakly acidic pH range. One having ordinary skill in the art would interpret a pH of 5.0-7.0 as “weakly acidic.”

Although Oshimura does not appear to explicitly teach a formulation in the instantly claimed pH range, it would have been prima facie obvious to one having ordinary skill in the art to adjust the pH to the weakly acidic range. One would have been motivated to do so because Oshimura teaches that such a range is mild to skin, exhibits less stretching feeling of the skin after use and also less irritation (page 2, lines 23-28).

Regarding claim 19, formulation example 3 incorporates sodium stearate into the preparation.

Regarding claim 23, page 3, line 39 of Oshimura teaches that that the N-long-chain-acyl dipeptides can be used in combination with one another (page 3, line 39).

Regarding claims 24-25, Oshimura teaches that the ratio of the dipeptide component and the N-long-chain-acyl acidic amino acid may be varied between 0.1:100 and 20:100 while still achieving satisfactory results. Oshimura further teaches that the amount of component (C), the fatty acid or a fatty acid salt, can be up to 30%. This teaching is further exemplified through the formulations taught by pages 12-14 of the reference.

Conclusion

No claims are currently allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TANIA ASHBY whose telephone number is (571)270-1348. The examiner can normally be reached on Monday through Friday, 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TA/

/David J Blanchard/
Primary Examiner, Art Unit 1643